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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,313	12/05/2003	Marco Baroni	IVD 971-3	1363

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EXAMINER

MORRIS, PATRICIA L

ART UNIT PAPER NUMBER

1625

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/729,313

Applicant(s)

BARONI ET AL.

Examiner

Patricia L. Morris

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 9,11,13,14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8,10,12,15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/331,524.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 8, 10, 12, 15, 17 and 18 are under consideration in this application.

Claims 9, 11, 13, 14 and 16 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

### ***Election/Restriction***

Applicant's election with traverse of Group I in the reply, filed August 19, 2004, is acknowledged. The traversal is on the grounds that the claims of Groups I-IV are merely directed to different aspects of a single inventive concept and should be examined together. This is not found persuasive for the reasons set forth in the previous Office action. Further, applicants have failed to advance any cogent reasons as to why the inventions are not patentably distinct.

### ***Claim Rejections - 35 USC §103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

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37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 10, 12, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nador et al. (WO 91/08200).

Nador et al. generically embrace the instant compounds and compositions. Note the compounds of formula (I) wherein Ar<sup>1</sup> and Ar<sup>2</sup> represent substituted phenyl, R<sup>1</sup> and n is zero.

It is believed that one having ordinary skill in the art would have found the claimed compounds *prima facie* obvious, since they are generically embraced by the disclosed formula; In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also In re Malagari, 499 F.2 1297, 182 USPQ 549 (CCPA 1974); In re Lemin, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); In re Rosicky, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by Nador et al. Accordingly, one having ordinary skill in the art would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims, with the expectation that each of them would have pharmaceutical utility.

It is believed well settled that a reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); In re Lamberti, 545 F.2d 747, 192 USPQ 278

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(CCPA 1976); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Susi, supra.

Claims 8, 10, 12, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nador et al. in view of Steiner et al. (US 5,512,584).

Nador et al. teach analogous compounds having pharmaceutical uses. The prior art compounds differs from the compound claimed herein as homologs. For example, note the specific reference compounds, ex nos. 11, 13, 14, 19 etc., therein. The prior art compounds are but the next adjacent homologs of the instant compounds. Moreover, Steiner et al. teach that the variation in the methylene adjacent to the ring retains pharmaceutical activity. The motivation to make these compounds is their close structural similarities to the disclosed compound. Note that the disclosed compounds have pharmaceutical activity, thus the skilled artisan would expect such structurally similar compounds to possess similar properties. While homology is considered to be present even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. Attention, in this regard is directed to In re Druey et al., 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

"We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants that the term homologue is used by chemists at times in a broad sense, and at other times in a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

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Also, as the Court stated in In re Payne et al., 606 F.2d 302, 203 USPQ 245 at 255

(CCPA 1979):

“the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.”

In addition, any question of why would one conceive and use the similar compounds (*i.e.* “motivation”) is answered by the Court in In re Gyurik et al., 596 F.2d 1012, 201 USPQ 552 at 557.

case “In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

size It has been long established that this type of structural relationship-varying the of a linking carbon chain - is per se obvious. Specifically, In re Shetty, 195 USPQ 753, In re Wilder, 195 USPQ 426, and Ex parte Gresham, 121 USPQ 422 all feature a compound with a C<sub>2</sub> link rejected over a compound with a C<sub>1</sub> link. Similarly, In re Chupp, 2 USPQ 2nd 1437 and In re Coes, 81 USPQ 369 have a C<sub>1</sub> link unpatentable over a C<sub>2</sub> link.

### ***Claim Rejections - 35 USC § 112***

Claims 12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The term containing in claims 12 and 15 is open-ended because it allows for the inclusion of other active ingredients.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockheed Aircraft Corp. v. United States, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

#### ***Priority***

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in France on December 24, 1996. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter. Applicants are requested to update the status of the parent application, Ser. No. 10/044,221 on page 1 of the specification. Cooperation herein is appreciated.

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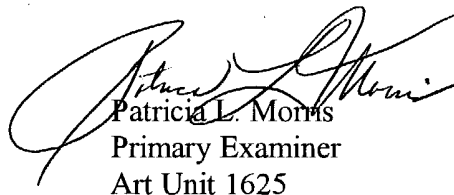
***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
October 26, 2004